

*REMARKS/ARGUMENTS**The Pending Claims*

Claims 36, 37, and 40-70 currently are pending. Claims 36, 37, and 40-50 are directed to the recombinant vector. Claims 51-56 are directed to a cell comprising the recombinant vector, and claims 57-66 are directed to the method of producing the recombinant vector. Claims 67-70 are directed to a method of mutagenizing an infectious viral genomic sequence in the aforementioned recombinant vector.

The Amendments to the Claims

In order to advance prosecution of the subject application, claims 71 and 72 have been cancelled. Claim 43 has been amended to correct claim dependency. No new matter has been added by way of these amendments.

The Office Action

The Office Action raises the following concerns:

(a) a certified translation of the German priority application must be provided in order to obtain the benefit of foreign priority under 35 U.S.C. §§ 119(a)-(d),

(b) the sequence listing filed on September 1, 2005 allegedly does not comply with 37 C.F.R. §§ 1.821-1.825 because the submission allegedly did not include a statement directing entry of the paper copy of the sequence listing into the specification,

(c) claims 36, 37, 40-43, 46-48, 50-51, 53-54, 56-64, and 67-72 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Messerle et al., *Proc. Natl. Acad. Sci. USA*, 9: 14759-14763 (1997) ("the Messerle 1997 reference"),

(d) claims 36, 43, 48, 51, 54, 57-60, and 63 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Delecluse et al., *Proc. Natl. Acad. Sci. USA*, 95: 8245-8250 (1998) ("the Delecluse reference"),

(e) claims 71-72 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Messerle et al., *J. Mol. Med.*, 74(4): B8 (1996) ("the Messerle 1996 reference"),

(f) claim 71 is rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Luckow et al., *J. Virol.*, 67: 4566-4579 (1993) ("the Luckow reference"),

(g) claims 36, 48, 51, 54, 57-60, 63-64, 67-69, and 71 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6,277,621 ("the '621 patent"),

(h) claims 37, 40-43, and 72 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over the '621 patent in view of the Messerle 1996 reference, and

(i) claims 43 and 44 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite.

Reconsideration of these rejections is respectfully requested.

Discussion of Foreign Priority

The Office Action indicates that a certified English translation of the German priority application must be provided in order to obtain the benefit of foreign priority under 35 U.S.C. §§ 119(a)-(d). Applicants submit herewith the requested certified translation. The priority date of the subject application is August 1, 1997 (i.e., the filing date of the German priority application).

Discussion of Sequence Listing

The sequence listing filed on September 1, 2005 allegedly does not comply with the requirements of 37 C.F.R. §§ 1.821-1.825. Applicants note that, contrary to the Office Action's allegation, amendment of a sequence listing does not require a statement directing entry of the sequence listing into the specification. In accordance with 37 C.F.R. § 1.825, an amendment to a sequence listing requires the following: (1) submission of substitute sheets and a replacement disc setting forth the amended sequence(s), (2) a statement that the substitute sheets and replacement disc include no new matter, and (3) a statement that indicates support for the amendment in the application as filed. Applicants submit that the sequence listing filed on September 1, 2005, meets the above enumerated requirements, and therefore complies with the requirements of 37 C.F.R. §§ 1.821-1.825.

Discussion of Rejections Under 35 U.S.C. §§ 102(a) and (e)

Claims 36, 37, 40-43, 46-48, 50-51, 53-54, 56-64, and 67-72 have been rejected under Section 102(a) as allegedly anticipated by the Messerle 1997 reference. Claims 36, 43, 48, 51, 54, 57-60, and 63 have been rejected under Section 102(a) as allegedly anticipated by the Delecluse reference. Claims 36, 48, 51, 54, 57-60, 63-64, 67-69, and 71 have been rejected under Section 102(e) as allegedly anticipated by the '621 patent.

A publication qualifies as prior art under Section 102(a) if the publication was by another and occurred prior to the date of invention for the claims in issue. A patent qualifies as prior art under Section 102(e) if the patent has an effective U.S. filing date prior to the date of invention for the claims in issue. Here, the Messerle 1997 reference was published in December 1997, and the Delecluse reference was published in July 1998. The '621 patent allegedly has an effective U.S. filing date of February 26, 1998. However, the date of invention for the claims in issue is at least as early as August 1, 1997, i.e., before the publication dates of the Messerle 1997 reference and the Delecluse reference, and before the alleged effective U.S. filing date of the '621 patent, as demonstrated by the text of the German patent application to which the present application claims priority under 35 U.S.C. § 119. A certified English translation of the German patent application to which the present application claims priority is concurrently filed herewith. As is apparent from the English translation, the German patent application fully supports the pending claims, and it is clear that Applicants invented the subject matter of the pending claims prior to the publication of the Messerle 1997 reference and the Delecluse reference, and prior to the alleged effective U.S. filing date of the '621 patent. As a result, the Messerle 1997 reference and the Delecluse reference are not prior art to the pending claims under 35 U.S.C. § 102(a), and the '621 patent is not prior art to the pending claims under 35 U.S.C. § 102(e). See also M.P.E.P. § 2136.05.

Discussion of Rejections Under 35 U.S.C. § 102(b)

Claims 71-72 have been rejected under Section 102(b) as allegedly anticipated by the Messerle 1996 reference, and claim 71 has been rejected under Section 102(b) as allegedly anticipated by the Luckow reference. Solely in an effort to advance prosecution of the

subject application, and not in acquiescence of the rejections, claims 71 and 72 have been cancelled. As such, the Section 102(b) rejections are moot and should be withdrawn.

Discussion of Rejections Under 35 U.S.C. § 103

Claims 37, 40-43, and 72 have been rejected under Section 103(a) as allegedly obvious over the '621 patent in view of the Messerle 1996 reference. This rejection is traversed for the reasons set forth below.

As discussed above, the '621 patent is not prior art to the pending claims. Moreover, the Messerle reference does not disclose using a bacterial host cell that contains mutagenizing DNA molecules to produce BAC/MCMV hybrid molecules. Claim 72 has been cancelled. Thus, the invention defined by claims 36, 37, and 40-43 is not obvious in view of the cited references, whether considered alone or in combination. Applicants, therefore, respectfully request withdrawal of the Section 103 rejection of these claims.

Discussion of Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 43 and 44 are rejected under Section 112, second paragraph, as allegedly indefinite because they depend from a cancelled claim. Claim 43 has been amended to depend from claim 36, thereby mooting this rejection.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,



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Date: June 13, 2006